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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/546,097	04/10/2000	Henrick K. Gille	08041-007001	2573
20985	7590	01/21/2004		
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			EXAMINER JOHNSON III, HENRY M	
			ART UNIT	PAPER NUMBER
			3739	
DATE MAILED: 01/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/546,097

Applicant(s)

GILLE ET AL.

Examiner

Henry M Johnson, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/19/2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 28-96 is/are pending in the application.
- 4a) Of the above claim(s) 13-23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 and 56-62 is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☒ Claim(s) 3,4,7,33,37,38,45,49,50,64,65,68,73,75,76,79,87,88,91,92,95 and 96 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Continuation of Disposition of Claims: Claims rejected are 1,2,5,6,8-12,29-32,34-36,39-44,46-48,51-55,63,66,67,69-72,74,77,78,80-86,89,90,93 and 94.

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## DETAILED ACTION

### *Claim Objections*

Claim 82 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The contact electrode is cited in the base claim.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 8, 10, 11, 29, 32, 34, 40, 41, 42, 44, 46, 52, 53, 54, 63, 69, 71 and 72 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,228,800 to Degler et al. Degler et al discloses an electrosurgical instrument comprising an electrically insulated housing, constructed of a nonconductive material and having a substantially pencil shaped configuration, a blade assembly mounted in said housing and projecting from said housing, said blade assembly comprising a center electrode, insulation means on opposite sides of said electrode and side electrodes (Col. 7, lines 7-12). The center electrode has a beveled cutting edge and is stainless steel and the side electrodes are silver (Col. 7, line 39). The beveled edges form an angular cutting surface around the electrode body (Col. 4, lines 43-44). The tip is essentially shaped like a lance (Figs. 3 and 5) and the electrodes are connected to the energy source (Fig. 2) via contacts (Fig. 3, #39) in the housing. A switch in the handle is provided to energize the electrode. The side electrodes are interpreted as meeting the requirement for at least one electrode attached to a non-mechanical cutting edge of the tip. The electrodes of the

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applicant's disclosure are cited as "formed on both sides of the tip" on page 4, line 6 and line 27, thus supporting the edge cited in the claims as being defined as "the area or part away from the middle" (The American Heritage® Dictionary of the English Language: Fourth Edition).

Claims 1, 2, 10, 29, 30, 32, 34, 41, 44, 46, 53, 63, 71, 74, 85, 86 and 94 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,248,231 to Herczog et al. Herczog teaches a surgical cutting instrument with a cutting edge made of an insulating material (Col. 2, lines 35-40) with electrodes attached to the sides (non-mechanical cutting edges) of the instrument and electrically connected to an electrical source (Fig. 1). The electrodes may be made of platinum (Col. 1, line 47). The cutting edge is detachable from the handle (Col. 3, line 35).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 6, 9, 35, 36, 39, 47, 48, 51, 66, 67 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,228,800 to Degler et al in view of U.S. Patent 4,640,279 to Beard. Degler et al is discussed above but does not teach the use of a non-stick coating. Beard discloses a surgical scalpel with an electrode attached to a non-cutting edge with a form of polytetrafluorethylene coating to provide a frictionless, non-stick finish (Col. 4, lines 15-18). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the coating as taught by Beard in the invention of Degler et al to keep tissue from sticking to the device and reduce friction of the device in the tissue.

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Claims 12, 43, 55 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,228,800 to Degler et al in view of U.S. Patent 5,925,043 to Kumar et al. Degler et al is discussed above, yet does not teach the use of titanium nitride in the electrode. Kumar et al discloses an electrosurgical blade with a coating of titanium nitride (Col. 6, line 13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose titanium nitride as taught by Kumar et al in the electrode of Allen as an obvious design choice.

Claims 31, 74, 80, and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,228,800 to Degler et al in view of U.S. Patent 5,413,575 to Haenggi. Degler et al is discussed above, yet does not disclose the blade as being detachable. Haenggi teaches a multifunction electrocautery tool with a removable blade (Col 6, line 43). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the blade of Degler removable as taught by Haenggi to enable the blade to be replaced independently of the total assembly.

Claims 77, 78, and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,228,800 to Degler et al in view of U.S. Patent 5,413,575 to Haenggi as applied to claim 30 above, and further in view of U.S. Patent 4,640,279 to Beard. Beard discloses a surgical scalpel with an electrode attached to a non-cutting edge with a form of polytetrafluorethylene coating to provide a frictionless, non-stick finish (Col. 4, lines 15-18). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the coating as taught by Beard in the invention of Degler et al as modified by Haenggi to keep tissue from sticking to the device and reduce friction of the device in the tissue.

Claim 84 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,228,800 to Degler et al in view of U.S. Patent 5,413,575 to Haenggi as applied to claim 30

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above, and further in view of U.S. Patent 5,925,043 to Kumar et al. Kumar et al discloses an electrosurgical blade with a coating of titanium nitride (Col. 6, line 13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose titanium nitride as taught by Kumar et al in the electrode of Degler et al as modified by Haenggi as an obvious design choice.

Claims 89, 90 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,248,231 to Herczog et al in view of U.S. Patent 4,640,279 to Beard. Herczog et al is discussed above but does not teach the use of a non-stick coating. Beard discloses a surgical scalpel with an electrode attached to a non-cutting edge with a form of polytetrafluorethylene coating to provide a frictionless, non-stick finish (Col. 4, lines 15-18). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the coating as taught by Beard in the invention of Herczog et al to keep tissue from sticking to the device and reduce friction of the device in the tissue.

### ***Response to Arguments***

The Applicant's arguments filed 12/19/2003 have been fully considered. The rejections based on Degler et al are affirmed. Degler et al provides at least one electrode attached to a non-mechanical cutting edge of the tip. While the center electrode is on the cutting tip, the side electrodes (Fig. 7, #'s 37 and 38) are attached to the side of the device, not on the cutting tip. How Degler et al uses, or intends to use, this device is not relevant to the apparatus claims. The structure required is that at least one electrode is not attached to the cutting edge of the tip and Degler et al clearly anticipates that requirement by being attached to the side edge of the tip. New claims that require the cutting edge to be formed of a non-electrode portion is anticipated by Herczog. Note that Beard would also read on new claim 85.

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***Allowable Subject Matter***

Claims 28 and 56-62 are allowed.

Claims 3, 4, 7, 33, 37, 38, 45, 49, 50, 64, 65, 68, 73, 75, 76, 7987, 88, 91, 92, 95 and 96 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M Johnson, III whose telephone number is (703) 305-0910. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Henry M Johnson, III  
Patent Examiner  
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Hmj

  
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